

Remarks

Claims 1 to 15 were pending. By this Amendment, claim 1 to 6 and 8 to 13 have been amended and claims 16 and 17 have been added. In particular, applicants have deleted the recitation "or the individual optical isomers, mixtures of the individual enantiomers, racemates" from the claims since that subject matter is understood to be within the scope of a claim to a compound and therefore does not change the scope of the claims thereby. Applicants maintain that no new matter has been added by these amendments and therefore respectfully request that the Examiner enter the amendments presented. Amended claims 1 to 17 are now pending in this application.

The Examiner objected to claims 11 and 13 under 37 C.F.R. § 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim.

In response, applicants have amended claims 11 and 13 and maintain that such amendments render the Examiner's rejection moot. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner rejected claims 1 to 5, 7, 9, and 10 under 35 U.S.C. § 103(a) as allegedly obvious over the combined teachings of Schromm *et al.* I (U.S. Patent No. 4,460,581) and Schromm *et al.* II (U.S. Patent No. 5,223,614).

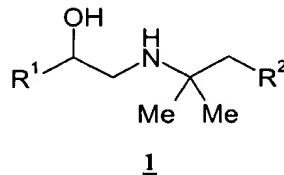
In response, applicants respectfully traverse the Examiner's obviousness rejection and contend that the rejection is improper. A *prima facie* case of obviousness requires the satisfaction of three criteria: (i) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings; (ii) there must be a reasonable expectation of success; and (iii) the references when combined must teach or suggest all of the claim limitations. See M.P.E.P. § 2143. The lack of any suggestion in the prior art cited by the Examiner to substitute methoxy for hydroxy renders the Examiner's rejection improper. See, e.g., *Ex parte Brouard*, 201 U.S.P.Q. 538, 540 (Bd. Pat. App. 1976). Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Applicants respectfully submit that all the pending claims are allowable and therefore solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone interview would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

Version of the Specification with Markings to Show Changes Made by this Amendment

In accordance with 37 C.F.R. §§ 1.121(b)(1)(iii) and 1.121(c)(1)(ii), the following marked up version of the specification amended herein is provided to show all of the changes relative to the previous version before the amendments herein.

--1. (Amended) A compound of formula 1

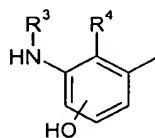


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wherein:

R¹ is

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wherein:

R³ is a benzyl group optionally substituted by a methoxy group,

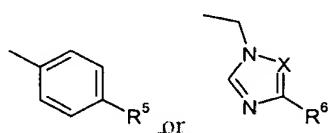
R⁴ is a hydrogen atom, or

R³ and R⁴ together are a -CO-CH₂-O- bridge, the carbonyl group of the bridge being bound to the nitrogen; and

R² is

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wherein:

R⁵ is a dimethylamino, methoxy, or butoxy group,

X is a nitrogen or a carbon atom, and

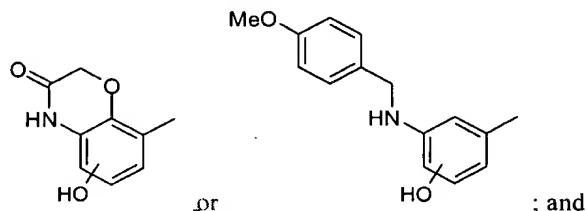
R⁶ is a methoxyphenyl group, if X is nitrogen, or is an anellated phenyl ring also linked to X, if X is carbon,

or acid addition salt thereof--

Deleted: or the individual optical isomers, mixtures of the individual enantiomers, racemates,

--2. (Amended) The compound of formula 1 according to claim 1, wherein:

R¹ is

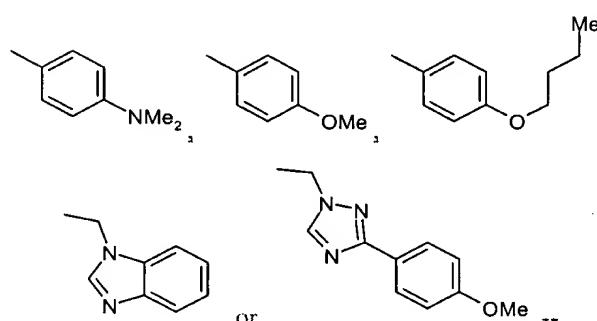


or ; and

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R² is

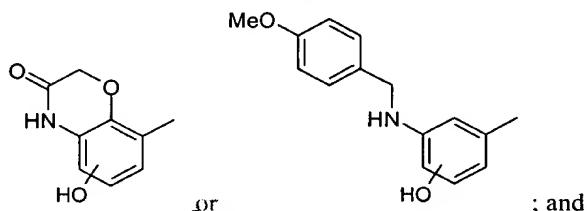


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--3. (Amended) The compound of formula 1 according to claim 1, wherein:

R¹ is



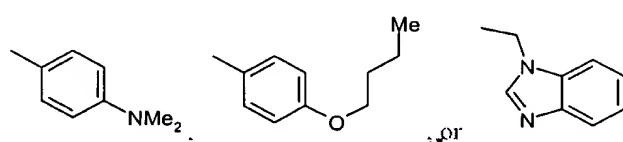
or ; and

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R² is



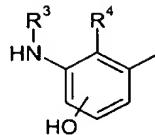
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--4. (Amended) The compound of formula 1 according to claim 1, wherein:

R¹ is

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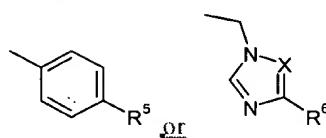


wherein R³ and R⁴ together are a -CO-CH₂-O- bridge, the carbonyl group of the bridge being bound to the nitrogen; and

R² is

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wherein:

R⁵ is a dimethylamino, methoxy, or butoxy group,

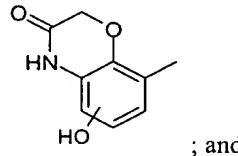
X is a nitrogen or a carbon atom, and

R⁶ is a methoxyphenyl group, if X is nitrogen, or an anellated phenyl ring also linked to X, if X is carbon.--

--5. (Amended) The compound of formula 1 according to claim 1, wherein:

R¹ is

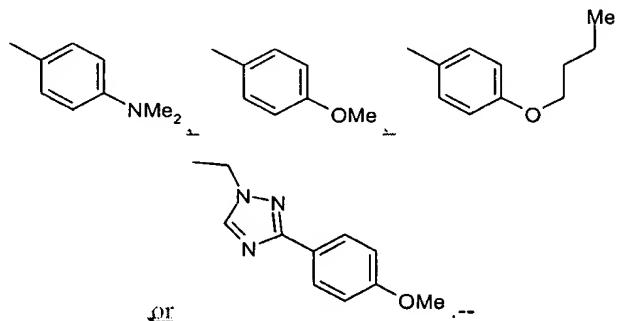
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; and

R² is

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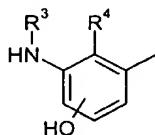


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--6. (Amended) The compound of formula 1 according to claim 1, wherein:

R¹ is

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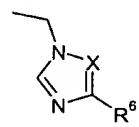
wherein:

R³ is a benzyl group optionally substituted by methoxy, and

R⁴ is a hydrogen atom; and

R² is

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wherein:

X is a nitrogen or a carbon atom,

R⁶ is a methoxyphenyl group, if X is nitrogen, or an anellated phenyl ring also linked to X, if X is carbon.--

--8. (Amended) 1-[3-(4-methoxybenzylamino)-4-hydroxyphenyl]-2-[4-(1-benzimidazolyl)-2-methyl-2-butylamino]ethanol, or an acid addition salt thereof.--

Deleted: or the individual optical isomers, mixtures of the individual enantiomers, racemates,

--9. (Amended) 1-[2H-5-hydroxy-3-oxo-4H-1,4-benzoxazin-8-yl]-2-[3-(4-N,N-dimethylaminophenyl)-2-methyl-2-propylamino]ethanol, or an acid addition salt thereof.--

Deleted: or the individual optical isomers, mixtures of the individual enantiomers, racemates,

--10. (Amended) 1-[2H-5-hydroxy-3-oxo-4H-1,4-benzoxazin-8-yl]-2-[3-(4-n-butyloxyphenyl)-2-methyl-2-propylamino]ethanol, or an acid addition salt thereof.--

Deleted: or the individual optical isomers, mixtures of the individual enantiomers, racemates,

--11. (Amended) The compound according to one of claims 1 to 6 or 8 to 10, wherein the acid addition salt thereof is formed with a pharmacologically acceptable acid.--

--12. (Amended) A method of treating bronchial asthma, the inflammatory component in COPD, premature onset of labor in midwifery (tocolysis), atrio-ventricular block, bradycardiac heart rhythm disorders, circulatory shock, or itching and inflammation of the skin in a host in

need of such treatment, the method comprising administering to the host the compound according to one of claims 1 to 6 or 8 to 10--

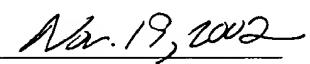
--13. (Amended) A pharmaceutical preparation comprising a compound according to one of claims 1 to 6 or 8 to 10 and a conventional excipient or carrier.

If the Examiner desires to discuss this case over the phone, the Examiner is invited to call the attorney for the applicant, Timothy X. Witkowski at 203-798-4310.

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on November 19, 2002.


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Dated

Respectfully submitted,



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